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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,822	04/06/2001	Tomohisa Yamaguchi	0020-4845P	6454
2292	7590	09/10/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,822

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/6/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-15 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding claims 1 and 7, the phrase "can operate" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
3. Regarding claims 14 and 15, the word "allowing" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Requirement for Information Under 37 C.F.R. § 1.105

4. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
5. The information required is the full translation of Japanese patents (JP 11338809 and JP 9163352). The patents were listed on an IDS submitted by applicant. The

Abstracts were submitted and translated in English. The Abstracts were of relevance to the instant application and therefore, the full translation of this patents is essential to the examination of the instant claims.

3. The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

5. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-10, 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (6,336,099 hereinafter Barnett).

With respect to claims 1-4, 7-9, 13-15 Barnett teaches an information communication system including an information terminal and an information collecting device for exchanging information via communication means (Figure 1). The information terminal device comprising advertisement information saving means for saving advertisement information (i.e. the coupon data package and associated advertising materials are transmitted by the online service provider 2 to the personal computer 6, where it is stored in the downloaded coupon data file 30a in the coupon database 30); display means (display 24); advertisement presenting means for displaying the saved advertisement information on the display means (Figure 4A-4B); advertisement using means for detecting a user operation by a user interface occurring upon display of an advertisement; advertisement use information storing means for storing the advertisement use information (i.e. coupon request and user data 4 is stored); advertisement use information sending means which is connected to the communication means and sends the stored advertisement use information to the information collecting device via the communication means (i.e. user data is sent to the coupon distributor 16); the information collecting device receives the advertisement use

information sent from the information terminal device via the communication means (see Figure 1); advertisement use information collecting means for collecting the received advertisement use information (Figure 1); the advertisement information saving means, advertisement presenting means, advertisement using means and advertisement use information storing means in the terminal device can operate even in a state that the advertisement use information sending means is not connected to the communication means (i.e. The offline coupon data management routines 32 are executed by the processor 26 in conjunction with the coupon database 30 in order to request, obtain, store, select, sort, and print coupons as desired. The offline coupon data management routines 32 are executed by selecting a desired function button 52, 54, 56, or 58 as shown in the offline display screen 50 in FIG. 4b. The offline display screen 50 is shown on the display 24 when the user runs the coupon data management program on his or her personal computer 6. The offline coupon data management routines 32 are executed in an offline fashion; that is, the user does not need to first be in online communication with the service provider 2).

With respect to claims 5-6, Barnett further teaches analyzing means for determining advertisement information to be sent to the information terminal device based on an analytical result (i.e. based on the information analyzed, subsequent advertisements are coupons are distributed)(col. 6, lines 62-65).

With respect to claim 10, Barnett further teaches the advertisement presenting means displays an advertisement by utilizing part of a screen display on the display means for prompting a user for confirmation (i.e. the user is presented with the ads and the user selects the ads in order to confirm the order of the coupons)(col. 8, lines 23-33); a service instructed by the advertisement using means is changing contents of the display advertisement (i.e. the advertisements are changed based on the information received)col. 6, lines 62-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett.

Claim 11 further recites presenting the advertisements when the power is turned off and suspending the turning off the power to instruct the service. Presenting information even when the power is turned off and suspending off the power to instruct for service well make sense in order to not discontinue the presentation of the information and to not further damage the system and delay the turning on of the power until service is rendered. It would have been obvious to a person of ordinary skill in the

art at the time of Applicant's invention to have included presenting the advertisements when the power is turned off and suspending the turning off the power to instruct the service in order to achieve the above mentioned advantage.

Claim 12 further recites a warning screen displayed on the display means when an application program is waiting for an operation and a service instructed by the advertisement using means is changing contents of the operation started after the operation wait state finishes. Official notice is taken that is old and well known to suspend an operation when a warning is displayed in order to avoid system's problems. It would have been obvious for a person of ordinary skill in the art at the time of Applicant's invention to have included a warning screen displayed on the display means when an application program is waiting for an operation and a service instructed by the advertisement using means is changing contents of the operation started after the operation wait state finishes in order to achieve the above mentioned advantage.

Point of contact

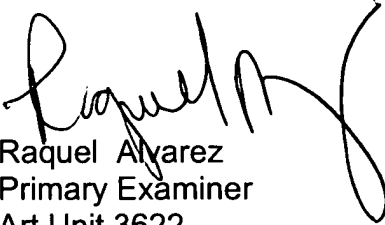
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
8/27/04